

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

Inventor:	Thomas Herren)	G.U.A.
Serial No.:	10/600,806)	3637
Title:	Multipurpose Construction Assembly and Method))	
Filed:	06/19/2003)	
Examiner:	A. Phi Dieu Tran)	

AMENDMENT AFTER NON-FINAL OFFICE ACTION

Mail Stop Amendments
Commissioner of Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

Responsive to the Official Action of November 15, 2006 (hereinafter the "Office Action"). Applicant further respectfully traverses the Examiner's rejection of this application pursuant to 35 U.S.C. §103 but, in order to proceed with the prosecution and preserve its ability to retain the elected species in a divisional application, elects to proceed with claims 1-6, 9, and 11-16.

Summary of Actions and Responses

Restriction Requirement

As to the restriction requirement, the Examiner has maintained that the truss embodiment (Claims 7-8, 10, and 17-20) are "directed to an invention that is independent or distinct from the invention originally claimed." In this second Office Action a Final restriction requirement has

been made as to claims 7-8, 10, and 17-19.

Rejections

The Applicant previously amended the claims to create a more generic claim that would cover the panel invention. After an interview and response to a First non-final Office action on June 19, 2006, The Examiner rejoined claims 3-4, 9, 11, and 13-16 with claims 1 and 2 of the application. Applicant would like to thank the Examiner for his reconsideration and rejoinder of these claims.

In this non-final Office Action, the Examiner has rejected claims 1-4, 9, 11, and 13-16 as being obvious under §103 in view of several prior art references.

Applicant's Responses

Response to Restriction Requirement

As to the restriction requirement, the Examiner has maintained that the truss embodiment (Claims 7-8, 10, and 17-20) are "directed to an invention that is independent or distinct from the invention originally claimed." As stated above, Applicant will proceed with the elected species in this application (1-4, 9, 11, and 13-16) and will file an appropriate divisional as to the non-elected claims.

Response to §103 Rejection of All Claims

Summary of the Present Invention

The present invention is a novel pre-fabricated construction panel having all sides capable of receiving slotted track and also having a special reinforcement member in the interior of the panel. It is specially designed and tested to withstand loads over 300 pounds per square

inch. There is no other panel in the prior art that discloses this feature. The panel of the present invention comprises a plurality of parallel studs framed and joined together by two horizontal and at least one vertical expansion-contraction studs. Further reinforcing the entirety of the panel is a special reinforcement member composed of a doubled 3-in-One® (Herren, US Patent No.6,260,318) creating a “boxed” shape which reinforces the entire panel to meet structural requirements for residential and commercial construction.

Summary of Rejections

The Examiner rejected all of the claims under §103 over Herren (6260318) in view of Digirolamo et al. (6612087), Hatzinikolas (5313752), and Telenaar (6705056). According to the Examiner, each of these references, if taken together, discloses an assembly or panel of the present invention.

Response to 103

The present invention was conceived because the inventor constructs structures in high-wind and hurricane prone areas. However, all construction techniques available to him did not disclose how to ensure that pre-fabricated structures would withstand hurricanes or similar climactic conditions. As such, there was needed a simple, cost-effective, way of creating a wall panel for quick construction and that could also withstand volatile climate changes.

To understand why Applicant does not believe the rejection is proper, a succinct description of each of the prior art references is necessary:

Herren: Only discloses a single, unique reinforcement member that can be inserted between two parallel studs but does not teach or suggest the combination of creating a boxlike backing structure for normal use or for use in a panel;

Digirolamo: Only discloses a connector for joining vertical and horizontal studs. The connector is secured to a “building member” with “slidable” fasteners. This reference also does not disclose the use of a box-like structure for reinforcement of the construction assembly;

Hatzinikolas: Only discloses a system and method for securing rail and studs with a specially designed slip joint.

Telenaar: Only discloses a backing member for use in a prior art wall and *teaches away from other backing members currently existing in the art.*

As a general comment to each of these references, what is not present in the prior art is a teaching, motivation, or even a suggestion to combine any of the above prior art elements for use in a panel of the present invention as is required by MPEP §2142. Furthermore, there must be a reasonable expectation of success found in the prior. *Id.* Simply assuming a person would have reasonably been able to do what the inventor did is insufficient as the examiner must present a “convincing line of reasoning” to show why? *Id.*

Although the panel of the present invention accounts for environmental forces and so can incorporate slidable fasteners securing parallel studs to horizontal structural members, the frame (outer horizontal and vertical supports) of the panel proper can also be rigidly secured either through screws or weld. This is nowhere taught or suggested by the prior art. Further a panel of the present invention cannot be inferred from a combination of the above elements because to determine whether or not the panel meets required load-bearing capacity requires that the panel be constructed and tested to demonstrate it can withstand extreme climate conditions. This is empirical data that is nowhere found in the prior art. Nor is there a teaching that any of the

above elements, when combined together as a panel will be sufficient to withstand regulatory load capacities.

Further, the Applicant would like to point to the disclosure of the application presented for explaining the claims which clearly disclose and describe the testing of these pre-fabricated panels that was done to ensure they meet *and even exceed* existing regulatory requirements. In the specification, Applicant discloses the invention as:

“... a construction assembly which may be used to form pre-fabricated floors, pre-fabricated exterior and interior walls which also serve as structural support for a multi-story edifice, and pre-fabricated trusses for the construction of roofs and ceilings.”

Additionally, the benefits over purchasing materials separately and for meeting structural requirements was also stated:

“[as avoiding] the cost of purchasing and installing structural steel to form the structural framework of a multi-story building. The unique bracing system incorporated into each assembly provides enough strength and integrity that the assembly can withstand 300 pounds per square foot of load.”

...

“[incorporating] a means for fire stopping in accordance with the BOCA National Building Code and the anticipated International Building Code. The BOCA Code defines “draft stopping” as “building materials installed to prevent the movement of air, smoke, gases, and flame to other areas of the building through large concealed passages.”

See BOCA §7.02.0 (1999). *See also* International Building Code §702.1 (1998).“

...

“The claimed invention also incorporates a means for the attachment of handrails and grab bars in accordance with American With Disabilities Act code requirements when the assembly as used as a wall structure.. The transverse brace between parallel studs in the claimed invention permits the anchoring of hand rail and grab bars which can with stand 250 pounds of point load pressure in accordance with the Americans with Disabilities Act.”

Even more so, further testing done on the panel of the present invention has even exceeded the 300 lbs capacity to 500 lbs and the specification can be amended to reflect this updated amount.

Last, and as in our first response, Applicant strongly contends that neither the Herren, diGirolamo, nor the Tollenaar patent teach or disclose any method or way to incorporate a slideable means for anchoring studs and a reinforcement member in a panel frame. Neither does the Hatzinikolas patent teach nor discloses any mechanism or method for providing a metal bridge or other fire stopping device for a similar panel as is stated in the present application much less a novel “boxlike” firestopping member as disclosed in the specification.

From the specification, and its Detailed Description which precisely teaches how to make a panel sufficient to achieve the objects of the present invention, none of the prior art teaches this type of panelization. As stated in our prior Office Action, there must be some teaching or suggestion, or motivation to combine or modify the references. In re Dance, 160 F.3d 1339, 1343 (Fed. Cir. 1993). Therefore, the question is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination and/or modification. Id.; Heidelberger Druckmaschinen v. Hantscho Commercial, 21 F.3d 1068, 1072

(Fed. Cir. 1994); In re Geiger, 815 F.2d 686, 688 (Fed. Cir. 1987). Consequently, it is incumbent upon the Examiner to show the motivation of the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, to select, combine, and/or modify the elements from the prior art references for combination in the matter claimed. In re Rouffet, 149 F.3d at 1357. Moreover, the fact that the modification or combination would be well within the ordinary skill in the art, by itself, is insufficient to meet this criterion. Al-Site Corp. v. VSI Intern., Inc., 174 F.3d 1308, 1324 (Fed. Cir. 1999).

Amendment to the Claims

Notwithstanding the novelty of the present invention just described, Applicant has again amended the claims to more clearly differentiate between the present invention and the prior art. Specifically, the claims have been amended to show that the assembly is a specially designed pre-fabricated panel that incorporates horizontal and vertical expansion members with a reinforcement member to meet existing load requirements for residential and commercial building structures.

Therefore, Applicant respectfully that the Examiner reconsider the claims in light of the differences disclosed and further requests that amended claims 1-4, 9, 11, and 13-16 be allowed to issue in their currently amended form.

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Conclusion

Applicants respectfully requests that a timely Notice of Allowance be issued in this case.

Respectfully Submitted,

Dated: January 15, 2007

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PLEASE RESPOND TO:

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